ESTTA Tracking number: **ESTTA655943**

Filing date: **02/13/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059915
Party	Defendant CA IP Holdings, LLC
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Attachments	92059915 Registrant's Response to Motion for Partial Judgment on the Pleadings.pdf(268434 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GE Nutrients, Inc., Petitioner v. CA IP Holdings, LLC, Registrant	Cancellation No. 92059915 Registration No. 4,302,581 Mark: TESTOGEN-XR

REGISTRANT'S RESPONSE TO PETITIONER'S MOTION FOR JUDGMENT ON THE PLEADINGS

Registrant/Counter-Claimant, CA IP Holdings, LLC (hereinafter "Registrant"), by and through its attorneys, THE CONCEPT LAW GROUP P.A, hereby responds to Petitioner/Petitioner's (hereinafter "Petitioner") Motion for Partial Judgment on the Pleadings with respect to Registrant's Third and Fourth Claims For Cancellation in Registrant's Answer to Petition for Cancellation, Affirmative Defenses, and Counterclaims to Cancel Petitioner's Registration No. 3,336,267 (hereinafter "Counterclaims"). For reasons detailed herein, this response is made on the grounds that Petitioner made a false statement in respect to the registration of the TESTOFEN mark in its response to the Office Action inquiry from the United States Patent and Trademark Office (hereinafter "USPTO). Accordingly, there is an issue of material fact as to whether Petitioner has knowingly made a false statement, with the intent to deceive, during the prosecution of the trademark application. Because a question of fact exists, Petitioner is not entitled to a partial judgment on the pleadings.

Dated: February 13, 2015

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GE Nutrients, Inc., Petitioner v. CA IP Holdings, LLC, Registrant	Cancellation No. 92059915 Registration No. 4,302,581 Mark: TESTOGEN-XR

BRIEF IN SUPPORT OF REGISTRANT'S RESPONSE TO PETITIONER'S MOTION FOR JUDGMENT ON THE PLEADINGS

Registrant/Counter-Claimant, CA IP Holdings, LLC (hereinafter "Registrant"), by and through its attorneys, THE CONCEPT LAW GROUP P.A, respectfully submits this Brief In Support of Registrant's Response To Petitioner/Petitioner GE Nutrients, Inc.'s (herinafter "Petitioner") Motion For Judgment on the Pleadings.

I. BACKGROUND AND FACTS

1. On June 22, 2005, Petitioner applied for registration of TESTOFEN, under 15 U.S.C §1051(b), on the Principal Register for "dietary supplements." DE 04, ¶ 29 (Registrant's Answer and Counterclaims).

2. On June 22, 2005, Petitioner submitted a sworn declaration to the USPTO that Petitioner possessed "a bona fide intention to use the mark in commerce on or in

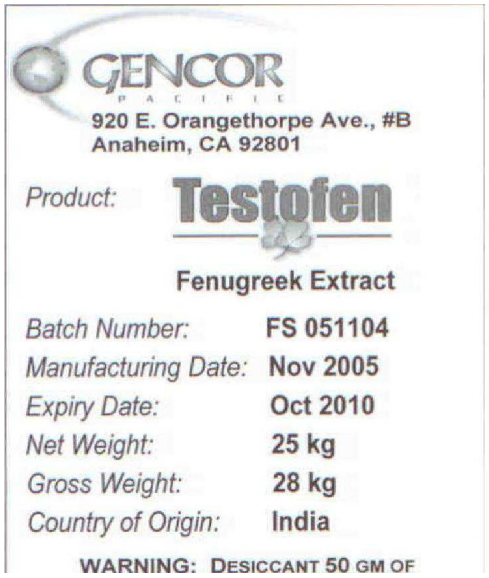
connection with the identified goods," which goods were, at said date, "dietary supplements" in international class 005. *Id*., ¶ 30.

3. On June 22, 2005, Petitioner submitted a sworn declaration to the USPTO in which it was declared under oath that "willful false statements, and the like, may jeopardize the validity of the application or any resulting registration…and that all statements made of his/her own knowledge are true." *Id*., ¶ 31.

4. On January 13, 2006, the USPTO issued an Office Action in connection with Petitioner's application, requiring that Petitioner "indicate whether the wording 'TESTOFEN' has any significance in the relevant trade or industry or as applied to the goods/services." *Id*., ¶ 32.

5. In response, on July 11, 2006, Petitioner responded that the "mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services." *Id*., ¶ 33. As stated in Registrant's pleading, Petitioner made a false representation to the USPTO, when Petitioner indicated, expressly as a result of a direct inquiry from the USPTO, that the wording 'TESTOFEN' had no significance in the relevant trade or industry, or as applied to the goods. *Id*.

6. As stated in Registrant's pleading, the term FEN does, in fact, have significance, as applied to the goods and/or in the relevant trade or industry. *Id*. More particularly, the term 'FEN' is descriptive of the singular ingredient in Petitioner's goods: fenugreek extract. *Id*. In fact, Petitioner's specimen of use, reproduced herein below, filed with the U.S Trademark Office on August 13, 2007, clearly demonstrates that Petitioner's goods are "fenugreek extract." *Id*., ¶¶ 33-34.

7. 

Id., ¶ 34.

8. Yet, in response to the January 13, 2006 Office Action, on July 11, 2006, Petitioner responded that the "mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services." *Id.*, ¶ 35.

9. In addition, as stated in the Registrant's pleading, Petitioner made a false representation to the USPTO, when Petitioner indicated, expressly as a result of a direct inquiry from the USPTO, that the wording 'TESTOFEN' had no significance in the relevant trade or industry, or as applied to the goods. *Id.* This is because the term TESTO does, in fact, have significance as applied to the goods or in the relevant industry, as descriptive of the result—an increase in testosterone—of ingestion of Petitioner's goods. *Id.*

II. ARGUMENT

A. Applicable Legal Standard for Judgment on the Pleadings

A motion for a judgment on the pleadings is decided only on the undisputed facts in the pleadings, supplemented by facts of which the Trademark Trial and Appeal Board

take judicial notice. *Ava Enterprises Inc. v. P.A.C Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008)**.** For purposes of the motion, all well pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because of no responsive pleading thereto) are required or permitted to be deemed false. *Id.* Conclusions of law are not taken as admitted. *Id.* (citing *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ 2d 1048 (TTAB 1992)). All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Id.* (citing *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ 2d 1048 (TTAB 1992)). Therefore, if the non-moving party's pleading raises issues of fact that, if proven, would establish that the non-moving party is entitled to judgment, the moving party may not obtain a judgment on the pleadings. *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ 2d 1048, 1049 (TTAB 1992).

In this case, there are genuine issues of material fact with regard to Counterclaims Three and Four. DE 04, ¶¶ 49-54 (Registrant's Answer and Counterclaims). Petitioner alleges that its statement to the USPTO was true and is therefore entitled to judgment as a matter of law. DE 06, pg. 6 (Motion for Judgment on the Pleadings). This, however, does not satisfy the requirements for a judgment on the pleadings. *Ava Enterprises Inc.,* at 1660 (finding the court must not take a moving party's factual allegation as true, rather, the court must analyze the motion by accepting the non-moving party's factual allegations as true for the purpose of the motion.). Further, the allegations of the moving party which have been denied must be deemed false. TBMP 504.02. In this case, Petitioner, in its Answer, denied the allegations contained in Paragraph 50 of Registrant's

Counterclaims, which amounts to a denial that Petitioner knew that FEN was descriptive of the single ingredient in Petitioner's goods. Therefore, for purposes of this motion, such denial must be deemed false.

B. Motion Should be Denied or Exhibits Excluded Because Matters Outside of the Pleadings Were Submitted

If, on a motion for judgment on the pleadings, matters outside the pleadings are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under Fed. R. Civ. P. 56. TBMP 504.03. Yet, for inter partes proceedings commenced on or after November 1, 2007, the Board is unlikely to treat a motion for judgment on the pleadings, filed prior to the moving party's service of initial disclosures and relying on matters outside of the pleadings, as a motion for summary judgment. *Id*. Treatment of a motion for judgment on the pleadings as a motion for summary judgment generally would result in a premature motion for summary judgment if the moving party had not served its initial disclosures prior to filing the motion. *Id*.

Petitioner's motion for judgment on the pleadings includes Exhibits that introduce matters outside of the pleadings, e.g. Exhibit G submits an email from counsel for Petitioner to counsel for Registrant, which was not in the pleadings. In Petitioner's motion, at least on pgs. 4 and 6, Petitioner makes the argument that because Petitioner's response to the office action at issue was *true*, as a matter of law, Petitioner did not commit fraud in procuring the registration of the TESTOFEN mark. However, such statements are inappropriate in a motion for judgment on the pleadings, which must be decided *solely on the facts appearing in the pleadings*. *See* TBMP 504.02. Moreover, such statements are an attempt to improperly submit facts outside of the pleadings. In

addition, such statements highlight the fact that there are indeed material issues of fact that should be allowed to proceed to the discovery period.

Petitioner's motion for judgment on the pleadings was commenced after November 1, 2007, was filed prior to the moving party's service of initial disclosures, and relies on matters outside of the pleadings; therefore the Board should not treat the motion as a motion for summary judgment. *See id*., 504.03.

Registrant submits that the motion is premature and should be denied. Alternatively, matters outside of the pleadings submitted with the motion should be excluded.

C. A Judgment on the Pleadings is Not Proper Because Whether Petitioner Knowingly Deceived the USPTO Is An Issue of Material Fact Necessary To Determine Fraud

Registrant's factual allegations, when taken as true for the purpose of this motion, would establish that Petitioner committed fraud in its trademark application and therefore, would defeat the Petitioner's motion.

In order to prove a claim of fraud in procurement of a trademark registration, it must be shown that: 1. Applicant has knowingly made; 2. A false and material representation; 3. With the intent to deceive the USPTO; 4. Shown by clear and convincing evidence. *In re Bose Corp.*, 580 F.3d 1240, 1244 (Fed. Cir. 2009)**.** This "subjective intent" to deceive is difficult to prove and therefore can be inferred from "indirect and circumstantial evidence." *Id.*

Registrant believes, and has factually alleged, that Petitioner knowingly made a material fraudulent representation to the USPTO with the intent to deceive. Petitioner did so by responding to an Office Action that the "mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services" despite believing that

the term TESTO was, in fact, significant, as descriptive of the result of ingestion of Petitioner's goods—an increase in testosterone—and knowing that the term FEN was, in fact, significant, as descriptive of the singular ingredient in Petitioner's goods: fenugreek extract. DE 04, ¶¶ 32-35. Petitioner's misrepresentation is material because, had Petitioner responded to the USPTO truthfully, that FEN and TESTO each have meaning within the relevant industry and/or as applied to the goods, then the USPTO would not have granted the descriptive trademark TESTOFEN.

Petitioner argues that even if the response to the Office Action is false, then no fraud has occurred because Petitioner believed the claim to be true. DE 06, pg. 4 (Petitioner's Motion for Judgment on the Pleadings). This allegation, however, cannot be taken to be true for the purposes of a motion for a judgment on the pleadings. *Ava Enterprises Inc.,* at 1660**.** Further, as the court in *In re Bose* explains, it is difficult to determine a party's subjective intent. *Bose Corp.*, 1244. Petitioner merely stating that it believed the response to the USPTO to be true is not enough to establish that there is no issue of material fact. *Id*. To the contrary, the difference between Petitioner's factual allegation of its intent and Registrant's factual allegation of Petitioner's intent raises an issue of material fact. Therefore, it is necessary for the partial motion for a judgment on the pleadings to be denied so Registrant may have an opportunity to engage in discovery and prove the disputed material fact of Petitioner's intent to deceive the USPTO. *Baroid Drilling Fluids Inc,* at 1249.

These issues of fact, if proven to be true, would establish that Registrant is entitled to a judgment. Therefore, Petitioner is not entitled to a judgment on the

pleadings and, therefore, Petitioner's Motion for a Judgment on the Pleadings must be denied.

D. Petitioner's Response to Office Action is Material Because Petitioner's Mark Would Not Have Been Approved if the USPTO Had Been Informed of the Meaning of FEN and TESTO Within the Relevant Industry or As Applied to the Goods

Petitioner's fraudulent response to the USPTO question regarding the meaning of TESTOFEN in the relevant industry and as applied to the goods is material because had the USPTO known that TESTO and FEN are each descriptive, then Petitioner's mark would have been denied for being merely descriptive.

A mark is considered to be merely descriptive if it "consists merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark." *DuoProSS Meditech Corp. v. Inviro Medical Devices*, *Ltd.*, 695 F.3d 1247, 1251 (Fed. Cir. 2012). Petitioner states in its motion for judgment on the pleadings that "it is axiomatic that a trademark must be considered as a whole, and one may not 'dissect' the mark into isolated elements." DE 06, pg. 8 (Petitioner's Motion for Judgment on the Pleadings). Petitioner's statement of the rule is, however, not complete. In fact, the very case which Petitioner cites goes on to state that "[t]he Board, to be sure, may ascertain the meaning and weight of each of the components that makes up the mark." *DuoProSS Meditech Corp.*, at 1253 (citing *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174 (Fed. Cir. 2004); *See also Lahoti v. Vericheck, Inc.*, 586 F.3d 1190, 1201 (9th Cir. 2009). The board may break a prospective mark into its components when determining the overall impression of the descriptiveness of the mark. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174 (Fed. Cir. 2004). When determining whether a word is descriptive the "question is whether someone who knows what the goods and services are

will understand the mark to convey information about them." *DuoPross Meditech Corp.*, at 1253 (citing *In re Tower Tech, Inc.*, 64 U.S.P.Q 2d 1314, 1316-17 (TTAB2002)).

In this case, Petitioner knew that the word FEN was descriptive of the single ingredient in Petitioner's goods—fenugreek extract. DE 04, ¶¶ 32-35. Petitioner also believed that the word TESTO was descriptive of the result of ingestion of Petitioner's goods—an increase in testosterone. *Id*. Petitioner, thereby knowing that the words TESTO and FEN were descriptive, willfully answered falsely as to material facts in response to a direct inquiry from the USPTO in an attempt to deceive the USPTO into believing that the wording TESTOFEN is not descriptive. The USPTO could not fully and properly analyze the mark TESTOFEN without Petitioner informing the USPTO of the material facts that TESTO and FEN are descriptive.

Petitioner's assertion that Registrant's counterclaim fails this theory is both inaccurate and irrelevant to the analysis of a judgment on the pleadings. The focus of the analysis is whether Registrant's factual allegations, when taken as true, establish an issue of material fact. *Ava Enterprises Inc.,* at 1660 (finding the court must not take a moving party's factual allegation as true, rather, the court must analyze the motion by accepting the non-moving party's factual allegations as true for the purpose of the motion.).

Petitioner knowingly answered falsely to material information, instead of truthfully answering the USPTO that TESTO and FEN each respectively have meaning within the relevant market and/or as applied to the goods. This information is material to the analysis of the descriptiveness of the word TESTOFEN and would have resulted in the mark being denied. The fact that Petitioner knowingly answered falsely to material factual information demonstrates Registrant's factual assertions that Petitioner has

committed fraud. *Id*. Therefore, Petitioner's intent for the response to the Office Action is an issue relating to a material fact and a partial judgment on the pleadings is not permitted.

III. CONCLUSION

Petitioner is not entitled to a judgment on the pleadings because Registrant's factual allegations of Petitioner's knowing material misrepresentation to the USPTO, when taken as true, would establish that Registrant is entitled to a judgment. Further, Petitioner's misrepresentation was material because, had the USPTO known of TESTO and FEN's meaning in the relevant industry and/or as applied to the goods, then Petitioner's mark would have been found to be descriptive and thereby denied. Therefore, Petitioner is not entitled to a judgment on the pleadings.

WHEREFORE, Registrant respectfully requests that this Honorable Board deny Petitioners motion for a judgment on the pleadings.

Dated: February 13, 2015

Respectfully submitted,

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Certificate of Mailing and Service

I certify that on February 13, 2015, the foregoing REGISTRANT's RESPONSE TO PETITIONER'S MOTION FOR JUDGMENT ON THE PLEADINGS is being served by mailing a copy thereof by U.S. first-class mail (USPS Tracking # 9114-9011-2308-6199-3500-91) to:

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